

Remarks

The referenced patent application has been reviewed in light of the referenced Office Action.

In the Specification, paragraphs 5, 6, 7, 20 and 25 have been amended to clarify Applicant's claimed invention.

In the Claims, claims 1-30 are pending in the referenced application. Claims 17, 22 and 27 have been amended to clarify Applicant's claimed invention.

In the Drawings, Figures 1, 2, 4A, 4B and 5 have been amended to clarify Applicant's claimed invention.

The Office Action objects to the disclosure because of informalities described in page 2 of the Office Action. The Specification as amended is free of the identified informalities.

The Office Action objects to the drawing because of an informality described on page 3 of the Office Action. The Specification as amended renders the Drawings free of the identified informality.

The Office Action objects to the drawings as failing to comply with 37 CFR 1.84(p)(5). The Drawings and Specification as amended are free from the defects identified in this context on Page 3 of the Office Action.

Therefore the drawings and specification as amended are now in compliance with 37 CFR 1.84(p)(5).

The Office Action objects to claims 17, 22, and 27 because of informalities described in page 3 and 4 of the Office Action. The Claims as amended are free of the identified informalities.

Claims 1-30 are provisionally rejected on the ground of non-statutory obviousness type double patent as being unpatentable over claims 1-30 respectively of co-pending Application No. 10/331,944 ('944 Application). The Office Action asserts that the limitations of claims 1-30 in the present Application are included in claims 1-30 of the '944 Application, and that one skilled in the art would be able to readily derive the limitations of the rejected claims based on the cited claims in the '944 Application because the '944 application claims a circuit which reads on an integrated circuit, and a controller circuit, which as claimed functions as a voltage regulator.

According to M.P.E.P section 804, a double patenting rejection of the obviousness-type is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. 103. Therefore, any analysis employed in an obviousness-type double patenting rejection must parallel the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 must be employed when making an obvious-type double patenting analysis. Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent application cited compared to a claim in the application under examination; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent application cited.

The Office Action makes a provisional obviousness type double patenting rejection without either specifically noting the differences between the inventions defined by the allegedly conflicting claims; or providing reasons why an artisan would conclude that the

invention defined by any of the claims at issue is an obvious variation of the invention defined in a claim in the patent application cited. Rather, the action merely makes the single, common, broad assertion for all the claims so rejected that the claims are not “patentably distinct from each other because the only differences are that [the ‘944 application] claims a circuit which reads on an integrated circuit and a controller circuit which as claimed functions as a voltage regulator.” In the above-quoted broad assertion there is insufficient reasoning provided as to the basis for the assertion of obviousness that must underlie a double-patenting rejection. Further, no additional basis is provided in the Action for the rejection.

For expediency, Applicant further respectfully disagrees with the Action in that in particular, Applicant asserts that a voltage regulator as claimed in the ‘944 application does not teach or suggest a more general type of circuit such as an a controller circuit as claimed in the present Application, and therefore, each claim in the present application which includes an element relating to an integrated circuit comprising a controller circuit is not obvious based solely on the claims of the ‘944 application. This rejection is therefore insufficient and at least for the above referenced reasons, cannot stand. Thus claims 1-30 cannot be rejected.

Therefore all claims pending in the application, claims 1-30, should be allowed.

The Examiner is welcome to contact the Attorney of Record, Sanjay S. Gadkari
(Reg. No. 55,796) at 503 264 4348 to discuss any matters with the case. The
Commissioner is hereby authorized to charge any fees in connection with this
communication to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: December 15, 2006

/Sanjay S. Gadkari/

Sanjay S. Gadkari
Reg. No. 55,796

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026
(503) 684-6200

I hereby certify that this correspondence is being deposited with
the United States Postal Service as first class mail with sufficient
postage in an envelope addressed to Commissioner for Patents,
P.O. Box 1400, Alexandria, VA 22313 on:

12/18/06

Date of Deposit

Annie Pearson

Name of Person Mailing Correspondence

Annie Pearson

Signature

12/18/06

Date